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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,505	04/06/2001	Elliott P. Dawson	12056-2	7931

23676 7590 03/07/2003

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EXAMINER

TRAN, MY CHAU T

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 03/07/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/827,505

Applicant(s)

DAWSON ET AL.

Examiner

My-Chau T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 11-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Applicant's amendment filed 12/10/02 in Paper No. 5 is acknowledged and entered.

Claims 1-10 are canceled. Claims 13 and 15 are amended. Claims 21-34 are added. Claims 11-34 are pending.

2. Applicant's election of Group II (Claims 11-20) in Paper No. 5 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement (*e.g. applicant cancel claims 1-10 of Group I*), the election has been treated as an election without traverse (MPEP § 818.03(a)).

Further, applicant has elected the following species for Group II (Claims 11-20):

- i. Species E (type of cutting device): a microtome, claim 12.
- ii. Species F (type of target-strands): a target substance embedded in a porous rod, claim 13.
- iii. Species G (type of bundle of target-strands): proteins, claim 14.
- iv. Species H ("stabilizing" material): epoxy, claim 18.

3. However, the newly submitted claims 21-34 are directed to an invention that is independent or distinct from the invention originally claimed and included patentably distinct species for the following reasons:

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:

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- I. Claims 11-28, drawn to a method of producing high density arrays of target substances, classified in class 436, subclass 55.
- II. Claims 29-34, drawn to a method of interrogating (screening) a high density array, classified in class 436, subclass 518.

5. Inventions of Group I (Claims 11-28) and Group II (Claims 29-34) are unrelated and independent invention. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different processes (e.g. Group I: process of making an array and Group II: process of screening an array) as claimed require different method steps, different materials, and produces different results. It is noted that the intermediate product formed by the process of group I can be made by materially different process, such as the arrangement of individual members of the array into an array or the deposition of the array by lithographic/masking processes. In addition the arrays can be screened (process of group II) in a variety of materially different processes such as cell adhesion assays, or as recited in the claims, screening for electrical or magnetic properties.

6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, and because they have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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7. It is noted that applicants *has already elect* the invention of Group II (Claims 11-20), which is now **Group I (claims 11-28)**, in Paper No. 5, applicants are required to further elect *one* species from a plurality of disclosed patentably distinct **type of “incorporated” material** of claim 20 and the newly submitted claims 25-28.

8. In the invention of **Group II (claims 29-34)**, applicants are required to further elect *one* species from a plurality of disclosed patentably distinct **type of interrogating (screening)** of the newly submitted claims 30-34.

9. It is noted that the newly submitted claims 21-24 are part of the species G, which is a type of bundle of target-strands, and applicant has *already elected one single species*. Therefore, claims 21-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner is on ***Increased Flex Schedule*** and can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 703-306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

mct
March 6, 2003


PADMASHRI PONNALURI
PRIMARY EXAMINER